

### Remarks

This responds to the Office Action dated March 17, 2008.

Claims 1, 9, 11, 16, 30 and 35 are amended. Support for the amendments to the claims can be found in the specification as originally filed, see, for example, page 3, lines 9-10; page 4, lines 10-12; and page 5, lines 4-13. Applicant respectfully submits that no new matter is added by way of amendment. Claims 1-11, 14-26, 30-40 and 44-45 are pending in this application.

### The 35 U.S.C. § 112, Second Paragraph, Rejection

Claims 9-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 9 and 11 to overcome this rejection.

### The 35 U.S.C. § 102 Rejection

Claims 1, 3, 5, 6, 9-11, 15, 16, 18, 21, 22, 25, 26, 35, 36, 39, 40, 44 and 45 were rejected under 35 U.S.C. § 102(b) for anticipation by Bolz et al. (U.S. Patent No. 5,964,794). Applicant respectfully traverses the anticipation rejection of claims 1, 3, 5, 6, 9-11, 15, 16, 18, 21, 22, 25, 26, 35, 36, 39, 40, 44 and 45.

“Anticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

### Claims 1, 16, 30 and 35

Applicant has amended claims 1, 16, 30 and 35 to better describe the subject recited in the claims. Applicant believes that claims 1, 16, 30 and 35 are not anticipated by the cited document since the document does not include each limitation of the recited claims. For instance, Applicant cannot find in the cited document: “...wherein the electrode includes a coating on at least a portion of a surface of the electrode leaving an uninsulated region...,” as recited in claim 1, “...wherein an outer surface of the electrode is coated on at least a portion of

a surface of the electrode leaving an uninsulated region...,” as recited in claim 16, “...wherein the electrode includes a coating on at least a portion of a surface of the electrode leaving an uncoated region...,” as recited in claim 30, or “...coating at least a portion of a surface of an electrode with a first layer leaving an uncoated region...,” as recited in claim 35.

Rather, Applicant respectfully submits that Bolz et al. disclose an electrode with a coating covering the entire electrode. See, for example, the Figures, in particular the Figure on the face page of the patent and Figure 5. Additionally, claim 1 recites “...a thin, specifically functionalized organic coating (1*b*; 1*c*; 1*b*”, 1*d*; 1*b*””, 17) forming the entire outer surface of the stimulation electrode” [emphasis provided].

Thus, Applicant respectfully requests reconsideration and allowance.

Claims 3, 6, 18, 22 and 36

Claims 3 and 6 include each limitation recited in claim 1. Claims 18 and 22 include each limitation recited in claim 16. Claim 36 includes each limitation recited in claim 35. Thus, claims 3, 6, 18, 22 and 36 are also not anticipated by the cited document. Reconsideration and allowance is respectfully requested.

Claims 5 and 21

Claim 5 includes each limitation recited in claim 1. Claim 21 includes each limitation recited in claim 16. Thus, claims 5 and 21 are also not anticipated by the cited document. Reconsideration and allowance is respectfully requested.

Claims 9, 25, 39, and 44

Claim 9 includes each limitation recited in claim 1 (as does claim 11). Claim 25 includes each limitation recited in claim 16. Claims 39 and 44 (as well as 45) include each limitation recited in claim 35. Thus, claims 9, 11, 25, 39 and 44-45 are also not anticipated by the cited document. Reconsideration and allowance is respectfully requested.

Claims 11, 26, and 40

Claim 11 includes each limitation recited in claim 1. Claims 26 includes each limitation recited in claim 25. Claim 40 includes each limitation recited in claim 35. Thus, claims 11, 26 and 40 are also not anticipated by the cited document. Reconsideration and allowance is respectfully requested.

Claim 15

Claim 15 includes each limitation recited in claim 1 and therefore is not anticipated by the cited document. Reconsideration and allowance is respectfully requested.

The 35 U.S.C. §§ 102/103 Rejection

Claims 30, 32 and 33 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bolz et al. (U.S. Patent No. 5,964,794). Applicant respectfully traverses the anticipation/obviousness rejection of claims 30, 32 and 33.

As discussed above, Applicant believes that claim 30 is not anticipated by the cited document. Claims 32 and 33 include each limitation recited in claim 30 and are therefore also not anticipated by the cited document.

Additionally, claims 30, 32 and 33 are not obvious over the cited document since the cited document does not teach or suggest all of the limitations of the rejected claims as discussed above. Furthermore, the explicit disclosure in Bolz et al. to coat the entire outer surface of the stimulation electrode (see, for example, claim 1 and Figure 5) teaches away from leaving a portion of the electrode uncoated. Thus, reconsideration and allowance is respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 2, 4, 7, 8, 14, 17, 19, 20, 23, 24, 31, 34, 37, 38 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bolz et al. (U.S. Patent No. 5,964,794). Applicant respectfully traverses the anticipation rejection of claims 2, 4, 7, 8, 14, 17, 19, 20, 23, 24, 31, 34, 37, 38 and 45.

Claims 2, 4, 7, 8, and 14 include each limitation recited in claim 1 and are therefore not obvious over the cited document since the cited document does not teach or suggest all of the limitations of the rejected claims.

Claims 17, 19, 20, 23, and 24 include each limitation recited in claim 16 and are therefore not obvious over the cited document since the cited document does not teach or suggest all of the limitations of the rejected claims.

Claims 31 and 34 include each limitation recited in claim 30 and are therefore not obvious over the cited document since the cited document does not teach or suggest all of the limitations of the rejected claims.

Claims 37, 38 and 45 include each limitation recited in claim 35 and are therefore not obvious over the cited document since the cited document does not teach or suggest all of the limitations of the rejected claims.

Additionally, the explicit disclosure in Bolz et al. to coat the entire outer surface of the stimulation electrode (see, for example, claim 1 and Figure 5) teaches away from leaving a portion of the electrode uncoated. Thus, reconsideration and allowance is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6905 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

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By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11 day of June 2008.

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